

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No.	:	09/538,431	Confirmation No. 7538
Applicant	:	Baiju D. MANDALIA	
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Examiner	:	Jerome GRANT II	
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Customer No.	:	23334	

**37 C.F.R. 1.132 AFFIDAVIT FOR INOPERABILITY OF
REFERENCES UNDER MPEP §716.07**

I, the undersigned, hereby declare the following:

- 1) My name is Glen R. Walters
- 2) I was born on November 19, 1969.
- 3) I reside at 5320 Pierce Street, Hollywood, Florida 33021.
- 4) I am a citizen of the United States of America.
- 5) I currently work as a Software Engineer at International Business Machines (IBM) Corporation.
- 6) I hold bachelor's and master's degrees in computer science from Florida State University. I am the co-inventor on 15 issued patents and have other patents pending. I am the chairman of the IBM Boca Raton Invention Evaluation Board and have received the award of IBM Master Inventor.
- 7) I have 10 years of experience working as a developer in the area of computer systems, programming, Internet, and enterprise content management.
- 8) I have reviewed the above-identified application, the patent of Serbinis et al (U.S. 6,314,425) and the Office Action dated August 18, 2004.
- 9) The pending claims of the above identified patent invention were reject as follows:
 - Rejected claim 18 under 35 U.S.C. §112, first paragraph, as failing to comply with enablement requirement;
 - Rejected claims 1-17 under 35 U.S.C. 102(e) as being anticipated by Serbinis et al. (U.S.

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Patent No. 6,314,425 B1); and

- Rejected claim 18 under 35 U.S.C. 103(a) as being unpatentable over Serbinis et al. (U.S. Patent No. 6,314,425 B1), in view of Official Notice.
- 10) In my technical opinion, the Serbinis patent does not teach or suggest the underlined claim limitations recited in independent claims 1, 10, 12, 14, and 16 as follows:

- Claim 1.

receiving at least one identifier over the telephone system for a document to be stored from a user's fax machine in the database;

receiving a fax reception over the telephone system from at least one user's fax machine of at least one document corresponding to the at least one identifier received;
and

storing the fax reception of the at least one document with the at least one identifier in the database, wherein the identifier associated with the at least one document and the identifier is capable of being searched in the database.

- Claim 10.

receiving at least one identifier over the telephone system for a document to be stored from a user's fax machine in the database;

receiving a fax reception over the telephone system from at least one user's fax machine of at least one document corresponding to the at least one identifier received;
and

storing the fax reception of the at least one document with the at least one identifier in the database, wherein the identifier associated with the at least one document and the identifier is capable of being searched in the database.

- Claim 12.

using the voice response system prompting the user for a category to be associated with a document to be faxed from the user using a voice response; and

receiving a fax from the user of a document to be stored in the database that is associated with a category under an account for the user.

- Claim 14.

receiving at least one identifier over the telephone system for a document to be stored from a user's fax machine in the database;

receiving a fax reception over the telephone system from at least one user's fax machine of at least one document corresponding to the at least one identifier received;
and

storing the fax reception of the at least one document with the at least one identifier in the database, wherein the identifier associated with the at least one document and the identifier is capable of being searched in the database.

• Claim 16.

a fax receiver coupled to the server for receiving faxes sent from a user's fax machine;

a telephone voice response system coupled to the server, the telephone response system having pre-recorded message prompts and voice recognition software for receiving user selections of the prerecorded message prompts, and the telephone response system receiving a message identifying a user; and

a database coupled to the server, the database capable of storing electronically faxes received from the user's fax machine along with user information including user selections and user identification.

More specifically, the Examiner on pages 2 and 3 of the Office Action states:

"With respect to claim 1, Serbints teaches a method for managing documents (1-n) in a client service system comprising: Coupling to a server system 17 with a database (25), one or more client systems (10, 11) over a network 15; linking the server to a telephone system (via load balance 45); receiving (from a computer 10, 11) at least one identifier (according to col. 7, line 27) over the telephone system for a document to be stored (according to col. 8, lines 17-30 and see also item 61 of figure 2) from a user's fax machine (col. 7, lines 58-65, teaches utilization of system in an environment) in the database; receiving fax reception over the telephone system from at least one user's fax machine of at least one document corresponding to an identifier; and storing the fax data with the identifier in the database, as discussed at col. 8, lines 12-25 and 48-52."

I respectfully and technically disagree with the Examiner's characterization of Serbinis teaching reception of documents from a user fax machine. Serbinis teaches web-based system management. Documents are presented, edited and uploaded via a web interface. See Serbinis Abstract. My careful reading of Serbinis discloses a fax notification from the document management system, not a fax reception to the document management system. Or in the words of Serbinis at col. 7, lines 59-65 (Emphasis Added):

Notification information tables 66 maintain information necessary to generate a notification message, and include entries for: notification transport type, i.e., e-mail, facsimile, voice, or pager; information on the status of the notification, i.e. pending, sent, failed; the recipient's notification identification; priority information; and optionally, the scheduled date/time for delivery.

Serbinis at col. 19, lines 39-50 (Emphasis Added)

Notification Processes

Referring now to FIGS. 12A and 12B, the notification request and confirmation services available on a preferred embodiment of DMS system 17 are described. Notification messages are generated by notification server 35 in response to various user events. For example, when a registrant registers for a DMS service, the registrant receives a notification with instructions on authorization, as discussed hereinabove with respect to step 178 of FIG. 9.

As another example, when an Originator has created an electronic document and uploaded that document to the DMS system. Authorized Users having access to the document may receive a notification that the document is available to be retrieved (as discussed with reference to steps 108 and 114 of FIG. 5). In this case, the notification may contain instructions on how the document may be retrieved from the DMS system.

The notification messages are digital and may take the form of an alphanumeric message, digital sound, digital image or other digital forms. DMS system 17 therefore preferably supports several types of notification transports including e-mail, fax, voice messaging and pager.

In fact, there are only two places in the entire Serbinis reference referring to facsimile or fax as quoted above. Accordingly, the notification of users by fax from the DMS as explicitly described by Serbinis is not the same as receiving a document to be stored by fax. In my technical opinion, the technical teachings of transmission by facsimile by the DMS system of Serbinis does not teach fax reception of a document by a user's fax machine for storage. The DMS system as taught by Serbinis without more, cannot operate to receive a document from a user's fax machine.

I, the undersigned, hereby declare that all statements made herein are of my own knowledge and are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. ' 1001 and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Name: Glen R. Walters:

Signature: 

Date: November 17, 2004